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PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT(S): William P. Newton, Robert M. Lucci, and Thomas F. Batten	
APPLN. NO: 08/839,161	EXAMINER: C. Cohen
FILED: 22 April 1997	ART UNIT: 3634
TITLE: SUPPORT SYSTEM FOR Laterally Removable SASH	

#22

PETITION TO THE COMMISSIONER UNDER 37 CFR §1.181
FROM HOLDING DATED 12 JULY 2000 OF NON-COMPLIANCE
OF BRIEF ON APPEAL

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

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Appellants petition the Commissioner under 37 CFR §1.181(1) for reversal of a holding that the Brief on appeal does not comply with 37 CFR 1.192(c)(7), *Ex parte Schier*, 21 USPQ2d 1016 (BPAI 1991) and *Ex parte Ohsumi*, 21 USPQ2d 1020 (BPAI 1991). Appellants believe that no fee is required; but if any fee nevertheless applies to this Petition, please charge the fee to Deposit Account No. 19-4518.

The Brief contains a statement at Section 7 on page 5 that the claims in different groups of claims as rejected do not stand or fall as a group. There is no holding that the statement about grouping of claims is inadequate.

The holding of non-compliance is based on the fact that the Argument section of the Brief offers separate reasons for patentability of two or more claims within a rejected group, rather than arguing separate patentability of each individual claim within a rejected group.

The Examiner notified appellants of non-compliance of the Brief in Paper No. 19, a copy of which is enclosed. Appellants

requested reconsideration in Paper No. 20, a copy of which is enclosed; and the Examiner maintained the non-compliance position in Paper No. 21, dated 12 July 2000, a copy of which is enclosed. A copy of the Brief in question is also enclosed.

The Examiner interprets 37 CFR 1.192(c)(7) [the "Rule"] as requiring a separate argument for each claim of every rejected group and bases non-compliance upon appellants' use of argument for separate patentability of two or more claims within a rejected group. Appellants disagree and believe that the Rule allows argument for separate patentability of two or more claims within a rejected group.

The language of the Rule itself does not require separate argument for each claim of a rejected group; and if the Rule intended this effect, it would be easy to say so. The Rule only requires the general statement about claims within rejected groups not standing or falling together, combined with argument giving additional reasons for patentability of claims within a rejected group. The Rule does not forbid subgrouping of claims within a rejected group or require a statement of which claims within a rejected group can stand or fall together.

The example given in the MPEP on page 1200-8 regarding compliance with the Rule hypothesizes claims 1-4 being rejected as a group, with separate patentability being argued only for claim 4. This indicates that appellants can pick the claims within a rejected group that warrant an argument for separate patentability, and it also shows that not every claim within a rejected group requires an argument of separate patentability.

The Rule requires appellants to supply arguments only for claims that are believed to be patentable separately from a rejected group of claims, and it gives appellants freedom of choice as to which claims within a rejected group deserve arguments for separate patentability. Nothing about these requirements prohibit argument for separate patentability of two or more claims within a rejected group.


The Examiner's interpretation of the Rule would also produce impractical results. It would require that an argument applicable to two or more claims within a rejected group be repeated redundantly for each of the claims in question. This would lengthen the Brief without adding to the information it contains.

The final rejection contains seven different groups of claims rejected as groups; and for each rejected group, the Brief follows the same pattern throughout the Argument section. The Brief argues first for the patentability of the entire group and then argues separate patentability of claims within the group. In some cases, the same argument for separate patentability is applied to two or more claims within the rejected group; and often, when more than one claim is included in a single argument for separate patentability, the claims involved are dependent and subdependent. This can be seen, for example, in the arguments against the rejection of claims 1-11 as a group, which includes separate patentability arguments for claims 2 and 3, 4-6, and 7-11.

Since appellants' Brief does comply with the rule by offering separate reasons for patentability of claims within rejected groups, appellants request that the Brief be held in compliance and that the appeal proceed through its remaining administrative steps.

Respectfully submitted,

EUGENE STEPHENS & ASSOCIATES


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ESS:cba

Enclosures

Dated: JUL 20 2000

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited on the date shown below with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C., 20231.

Date of Deposit: JUL 20 2000

Signature: 



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 20231

JUN 14 2000

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/839,161 04/22/97 NEWTON

W

PM82/0612

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EXAMINER

COHEN, C

ART UNIT

PAPER NUMBER

3634

19

DATE MAILED:

06/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Art Unit: 3634

**NOTIFICATION OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37
CFR 1.192(c)**

The brief includes a statement that the different groups of claims as rejected *do not* stand or fall as a group, but fails to present reasons in support thereof as required under 37 CFR 1.192(c)(5). MPEP § 1206. Since applicant has stated that each group of claims do not stand or fall as a group, applicant must argue each claim separately.

Appellant is required to comply with provisions of 37 CFR 1.192(c).

To avoid dismissal of the appeal, Appellant must comply with the provisions of 37 CFR 1.192(c) within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing of this communication; (2) within the time period for reply to the action from which appeal has been taken; or (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Cohen whose telephone number is (703) 308-2106.

The fax phone number for this Group is (703) 305-7687.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

C. Cohen *ck*

June 9, 2000

Daniel P. Stodola
Supervisory Patent Examiner
Group 3600



PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT(S):	William P. Newton, Robert M. Lucci, and Thomas F. Batten		
APPLN. NO:	08/839,161	EXAMINER:	C. Cohen
FILED:	22 April 1997	ART UNIT:	3634
TITLE:	SUPPORT SYSTEM FOR LATERALLY REMOVABLE SASH		

**RESPONSE TO NOTIFICATION OF NON-COMPLIANCE WITH THE
REQUIREMENTS OF 37 CFR 1.192(C) MAILED 12 JUNE 2000**

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

The Notification of Non-compliance with the Requirements of 37 CFR 1.192(c) (Notification of Non-compliance) asserts that appellants have failed to present reasons in support of separate patentability of claims within groups. The Notification of Non-compliance also asserts that appellants must argue each claim separately.

Both of these assertions are incorrect. First, appellants have given reasons for separate patentability of claims within groups. For each of the many groups of rejected claims, the Brief first gives arguments warranting allowability of all the claims in the group and, following this, the Brief offers additional reasons warranting allowability of specific claims within the rejected group. This fully meets both the letter and spirit of the rule. The statement in item 7 of the Brief informs the Board that the many groups of rejected claims do not stand or fall as a group. Then, as each rejected claim group is argued in section 8, the Brief gives both reasons for allowing claims of the rejected group as a whole and then additional reasons for allowing claims within the group.

Secondly, 37 CFR 1.192(c) does not include any additional requirement that appellants must argue each claim separately. The rule does not forbid argument for groups of claims and does not require a separate argument for each claim.

The Notification of Non-compliance does not mention recent telephone interviews between Examiner Cohen and appellants' attorney. In these interviews, Examiner Cohen called to propose amendments that would make allowable claims 1-11 and 53-90 if the remaining claims were canceled. Appellants' attorney refused to cancel the remaining claims, but was willing to make the amendments proposed for claims 1-11 and 53-90; because these were mostly redundant and did not make any real changes in claim scope.

Since appellants' Brief does meet the rule requirements, the Notification of Non-compliance should be withdrawn.

Respectfully submitted,
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Dated: JUN 21 2000

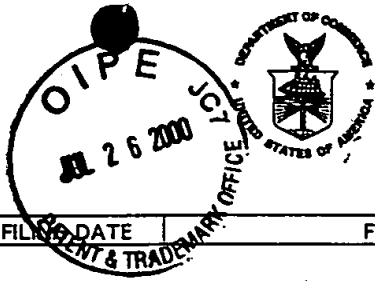
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5K
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

PM82/0712

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COHEN, C

ART UNIT

PAPER NUMBER

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21

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07/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

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Art Unit: 3634

The response filed June 23, 2000 is acknowledged. The response alleges that the Appeal Brief filed April 17, 2000 is in compliance with 37 CFR 1.192(c) contrary to the examiner's assertions in the communication of June 12, 2000 and as such there is nothing further to do on appellants' part.

Appellants' allegations to the contrary notwithstanding, the Appeal Brief of April 17, 2000 remains *not in compliance* with 37 CFR 1.192(c) for the reasons previously advanced in the Office communication of June 12, 2000, Paper No. 19. In this regard, it is noted that appellants clearly indicate that the claims do not stand or fall together. See Item 7 on page 5 of the Appeal Brief. However, appellants then proceed to argue various claims of each rejection in groups instead of each claim separately as required. For example, see pages 6 and 7. 37 CFR 1.192(c)(7) requires appellants to perform two affirmative acts in the brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. Appellants must state (A) that the claims do not stand or fall together *and* (B) present arguments why the claims subject to the same rejection are separately patentable. As per above, where appellants include the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together, i.e., are separately patentable, yet does not offer argument in support thereof in the "Argument" section of the brief, the brief is to be held in non-compliance as per 37 CFR 1.192(d). Note *Ex parte Schier*, 21 USPQ2d 1016 (BPAI 1991); *Ex parte Ohsumi*, 21 USPQ2d 1020 (BPAI 1991) and MPEP 1206.

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The statement made in Item 7 on page 5 of the Appeal Brief makes it very clear that appellants consider each claim of a respective ground of rejection to be separately patentable. However, appellants then proceed to argue these claims together in groups. For example, for the Section 102 rejection based on Haas, appellants state that claims 1-11, 29, 30, 32-34, 39-44, 46-48, 53-58, 60-63, and 67-73 do not stand or fall together. However, instead of arguing each of these "separately patentable" claims individually, appellants proceed to argue the patentability of these claims grouped as follows: 1, 2-3, 4-6, 7-11, 29, 30, 32-34, 39, 40, 41, 42, 43, 44, 46, 47-48, 53-58 and 60, 61-63, 67, 68, 69, 70-72, and 73. It can be readily seen that claims 3, 5, 6, 8, 9, 10, 11, 33, 34, 48, 54, 55, 56, 57, 58, 60, 62, 63, 71, and 72 have not been separately argued even though they have been stated to stand or fall separately, i.e., to be separately patentable. Accordingly, it is clear that appellants have not performed the two requisite steps and as such the Appeal Brief is in non-compliance since appellants have failed to present any argument as to why these claims are separately patentable.

With respect to the remarks made in the first paragraph of page 2, 37 CFR 1.192(c)(5) makes it very clear that appellants must provide an argument for each claim considered to stand or fall separately.

With respect to the remarks made in the second paragraph of page 2, failed attempts to place an application in condition for allowance by Examiner's Amendment have no bearing on the "compliance" of a Brief under 37 CFR 1.192.

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Appellants' TIME LIMIT for response of ONE (1) MONTH CONTINUES to run from the mailing date of the Notification of Non-Compliance, i.e., June 12, 2000. To avoid dismissal of the appeal, appellants must file a new complete brief (in triplicate) that fully complies with 37 CFR 1.192(c). Extensions of time under 37 CFR 1.136 are permitted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Cohen whose telephone number is (703) 308-2106.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

C. Cohen/ds

July 7, 2000

Daniel P. Stodola
Supervisory Patent Examiner
Group 3600